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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte REINHOLD HOLTKAMP SR.

Appeal 2007-4136  
Application 10/046,968  
Technology Center 1600

Oral Hearing Held: April 8, 2008

Before DONALD E. ADAMS, RICHARD M. LEOVITZ, and  
FRANCISCO C. PRATS, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

**RICHARD PEET, ESQ.**  
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3000 K Street, N.W., Suite 500  
Washington, DC 20007

The above-entitled matter came on for hearing on Tuesday, April 8, 2008, commencing at 9:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9<sup>th</sup> Floor, Hearing Room B, Alexandria, Virginia, before Kevin E. Carr.

1 JUDGE ADAMS: Good morning.

2 THE USHER: Calendar number 6, appeal number 2007-4136,  
3 Mr. Peet.

4 JUDGE ADAMS: Thank you.

5 Good morning, Mr. Pete

6 MR. PEET: Good morning.

7 JUDGE ADAMS: While you're getting ready, we are going to  
8 let you know that we've read your brief and are familiar with the case. And  
9 you have 20 minutes, and if you would spell your name into the record, we'd  
10 appreciate it, and you can begin when you're ready.

11 MR. PEET: Richard Peet, P-e-e-t. Thank you very much. I'm  
12 very happy to have the opportunity to speak to you today about our appeal.

13 The claims in this invention are directed to African violet plants  
14 that have at least one leaf axil with more than one flower stem. These plants  
15 as I'm sure you've seen from the specification and figures and the  
16 photographs that are there have multiple flowers, and they have been very  
17 popular in the marketplace. They were obtained in a very interesting way, as  
18 I am sure you have seen from the specification the seeds that gave rise to this  
19 mutation spent six years in space. And from the 25,000 seed that were  
20 incubated in space for that time period, a number of very interesting  
21 mutations were obtained, one of which is this multiflorescence characteristic  
22 which was described in the application.

23 The examiner has not cited any prior art that's on appeal here.  
24 We're dealing with enablement and written description rejections, and I'd  
25 like to if I could address the enablement rejection first. As you've seen,  
26 there was a deposit made of seed carrying the multiflorescence trait. And  
27 the examiner has taken the position that we haven't taught each and every  
28 way of making plants having this particular characteristic. And I think that's  
29 a mischaracterization of the law.

30 The specification, I think, contains a large amount of evidence  
31 and data showing that this particular trait can be introgressed or bred by  
32 traditional breeding methods well known to anyone with skill in the art in  
33 diverse genetic backgrounds, and this is the key to enablement in this case.  
34 In particular, I wanted to direct your attention to page 18 of the specification  
35 where the applicant has noted that in crosses of plants carrying

1 multiflorescence trait with plants that don't carry the trait, 50% of the  
2 progeny of that cross, exhibit the multiflorescent characteristic. And in  
3 crosses of plants, each containing multiflorescence trait, or exhibiting the  
4 multiflorescence trait, I should say, roughly 80% of the plants, progeny from  
5 those crosses, exhibit the trait.

6 JUDGE LEBOVITZ: Can I ask a question?

7 MR. PEET: Certainly.

8 JUDGE LEBOVITZ: What I saw in the spec, or in one of the  
9 claims, was that you get two to three stems. But the claims are broader than  
10 that. Is there any evidence that you can actually get more than three?

11 MR. PEET: You know, this was not an issue that was raised  
12 during examination; the number of stems, the examiner never raised that  
13 issue. The inventor has obtained plants with higher numbers of stems, and  
14 in fact with some varieties, as we note in the specification, the number of  
15 stems actually can increase as the plant matures. So that's an interesting  
16 characteristic of some of the plants that they've obtained from these crosses.

17 JUDGE LEBOVITZ: That's in the spec?

18 MR. PEET: Yes.

19 JUDGE LEBOVITZ: Can you direct me where?

20 MR. PEET: It's on 18, perhaps; yes, page 18, lines 13 through  
21 14.

22 JUDGE LEBOVITZ: Okay, thank you. So the older the plant,  
23 the more likely, have plants that have three or more flowers?

24 MR. PEET: In some varieties; I mean, that's been a  
25 characteristic that is variety dependent. And, I should note, that in the  
26 crosses as evidenced in the specification, when the trait is introgressed into  
27 these varieties and we give a number of commercial varieties that have been  
28 obtained by this method in the specification, importantly, the  
29 multiflorescence trait is stable through asexual propagation.

30 So what we have here is a method of introgressing the trait into  
31 diverse genetic backgrounds. It's not dependent upon the seed that's been  
32 deposited. Any plant from these crosses that exhibits the multiflorescence  
33 trait has been shown to be able to be a source of the gene or genes required  
34 for introgressing the trait, reproducibly and predictably into different genetic  
35 backgrounds. When you talk about the fact in the specification that the trait

1 can be recombined with different flower colors, different plant forms, a  
2 variety of different traits. So it's not for example linked to any particular  
3 characteristics. It can be introgressed into different genetic backgrounds;  
4 and, therefore, fully enabling in our view the scope of the claims.

5 JUDGE LEBOVITZ: So traditional breeding techniques, they  
6 are able to produce these African violets that have this multiflorescent trait  
7 that's not stable?

8 MR. PEET: Yes.

9 JUDGE LEBOVITZ: You can't pass it along down through  
10 generation after generation. Is that what you mean by stable?

11 MR. PEET: Yes, exactly. So in other words, once the trade is,  
12 let's say that you have as some of the examples, they've recombined the  
13 multiflorescence trait into a background with a different flower color and  
14 you can predictably make those crosses and recombine the multiflorescence  
15 trait with other characteristics that might be meaningful in the marketplace,  
16 such as flower color, plant form, and so forth.

17 JUDGE LEBOVITZ: Right. The traditional breeding  
18 technique can give rise to an African violet that has this multiflorescent  
19 trait. Correct?

20 MR. PEET: That's right. Once you have a source of a plant.

21 JUDGE LEBOVITZ: Okay. So how does the traditional  
22 breeding technique or the plant that's obtained by the traditional breeding  
23 technique differ from the plant in claim 1?

24 MR. PEET: The plant in claim 1 prior to the inventor's  
25 selection.

26 JUDGE LEBOVITZ: Well, take a look at how you've written  
27 claim 1. Now, you admitted to me just a few seconds ago that traditional  
28 breeding techniques can give rise to African violet cultivars that have more  
29 than one flower stem.

30 JUDGE LEBOVITZ: If you have a source of this unique  
31 mutation that wasn't previously known. Well, that's inconsistent with what  
32 you see at page 3 of the spec, right? Page 3 of the spec says "traditional  
33 rating techniques have failed to produce a stable African violet cultivar with  
34 more than one flower stem." Stable just means it's capable of passing it on  
35 to its progeny.

1 MR. PEET: Yeah. All that is meant there is that in the prior art  
2 there hasn't been any plants as far as we know and as far as the examiner  
3 determines, any plants exhibiting the multiflorescence characteristic. Once  
4 this particular mutation was obtained then they have found through--

5 JUDGE LEBOVITZ: That you can stably pass it on, right?

6 MR. PEET: Yeah, all that is meant there in the prior art there  
7 hasn't been any plants as far as we know, and as far as the examiner has  
8 determined, any plants exhibiting the multiflorescence characteristic. Once  
9 this particular mutation was obtained, then they have found.

10 JUDGE LEBOVITZ: That you can stably pass it on, right?

11 MR. PEET: That's right.

12 JUDGE LEBOVITZ: But there's nothing in claim 1 that's  
13 stable African violet claims comprising a stable multi-florescent trait.

14 MR. PEET: And we would argue that that's an inherent  
15 characteristic of once you have obtained this mutation that now it's possible  
16 to make as evidenced by the data in this application make plants that stably  
17 exhibit the multiflorescence trait.

18 JUDGE LEBOVITZ: That's not what you claim. See, I'm  
19 having trouble here with the statement at page 3 of your specification. It's  
20 the paragraph starting at line 2, thus far. So, take a moment and read  
21 essentially the first sentence.

22 MR. PEET: Yeah, and all that's being stated there is that as far  
23 as we know, the prior art did not teach the multiflorescence trait.

24 JUDGE LEBOVITZ: They didn't teach a stable multiflorescent  
25 trait.

26 MR. PEET: Yeah, or stable.

27 JUDGE LEBOVITZ: Well, it doesn't say "or stable." It just  
28 says they failed to produce a stable cultivar. Your first claim doesn't require  
29 a stable cultivar.

30 MR. PEET: Yeah, and in my view, it's not required, because  
31 the patentable invention here is the multiflorescence trait.

32 JUDGE LEBOVITZ: So if traditional breeding techniques can  
33 give rise to a multiflorescent trait, albeit that it's not stable, it reads on your  
34 claim. Right?

1 MR. PEET: No. And there's no prior art that the examiner, or  
2 we were not aware of any prior art that even teaches an unstable  
3 multiflorescence trait. The examiner has found that, I could see him or her  
4 using that in a prior art rejection that was never found. We are not aware of  
5 that either.

6 JUDGE LEBOVITZ: Yeah, but the sentence I directed you to  
7 is kind of strange, just because of the way it reads. It sort of infers that yea,  
8 we've seen these traits before, but they're just not stable. We can't pass them  
9 on.

10 MR. PEET: All we meant to confer there was the prior art does  
11 not teach as far as we know either stable or unstable multiflorescence. And  
12 the examiner never cited any prior art. We're not aware of, as I stand here  
13 today, any prior art that teaches this multiflorescence trait.

14 In terms of enablement, which was the issue the examiner was  
15 concerned about, I think the data is overwhelming in the application that you  
16 can introgress this trait into diverse backgrounds, whether it be the deposited  
17 seed or a plant exhibiting the multiflorescence trait to fully enable the scope  
18 of the claims.

19 JUDGE LEBOVITZ: Well, in terms of the enablement, what  
20 was the thrust of the examiner's argument, simply?

21 MR. PEET: Yeah. I think the main concern that I think the  
22 examiner had is that we didn't teach a number of different ways of making  
23 this multiflorescence trait; for example, that we didn't explain the genetic  
24 basis of it, whether it was a single gene, multiple genes. And, of course, we  
25 have no obligation to provide the theoretical underpinning. All we need to  
26 do is show that you can reproducibly, predictably, make the claimed plants  
27 using the methods that we have described in the application; and, I believe  
28 that's what the data in the application shows.

29 JUDGE LEBOVITZ: And, your position on the legal view is  
30 that under enablement law, you only need one way.

31 MR. PEET: That's correct, under Hogan and other cases.

32 JUDGE LEBOVITZ: One mode of making it.

33 MR. PEET: Under Hogan and other cases that we cite in the  
34 application that that's longstanding law.

1 JUDGE ADAMS: And, could you clarify? It seems to me in  
2 the enablement issue the examiner comes out and says, "This is a dominant  
3 trait." On the other hand, we have the written description issue and the  
4 examiner questions whether this trait is dominant or not dominant.

5 Would you clarify that inconsistent position for us?

6 MR. PEET: Yeah, I mean, I'm not certain that that's the basis  
7 of the examiner's concern about written description. I think the examiner in  
8 my view seems to mix up written description and enablement, because we  
9 have a very clear statement in the specification that at the time the invention  
10 was made, you know, we had possession of plants exhibiting the  
11 multiflorescence trait. That is, you know, at least one leaf axil with at least  
12 two or more flower stems.

13 With regard to enablement, it appears that the data would  
14 indicate that it's a dominant trait and it appears to segregate as a single gene.  
15 But, you know, we don't know that. As I stand here today, I don't know that  
16 for certain. That's my supposition based upon the data that's there; and, that  
17 would certainly support strong evidence of enablement in my view, because  
18 the data clearly shows if you have a plant with that multiflorescence trait,  
19 you can reproduce it predictably, select for progeny, and recombine it with  
20 other characteristics to produce plants that have the claimed characteristics  
21 in the full scope of the claim.

22 JUDGE ADAMS: We don't know anything about the genetics  
23 of this particular trait. We don't know how it's inherited, other than, and I  
24 think you just said it was dominant. Right?

25 MR. PEET: Well, you know, we don't state that in the  
26 application. But, if you look at page 18, the data that is provided indicates  
27 that in a cross between a plant that doesn't exhibit the multiflorescence trait  
28 with one that does, about fifty percent of the progeny will exhibit, the plants  
29 that are produced from that will exhibit, a multiflorescence trait.

30 JUDGE LEBOVITZ: That would be the case if it were  
31 heterozygous.

32 MR. PEET: That's right. That's right. But, you know, it could  
33 be much more complex than that.

34 JUDGE ADAMS: But no one knows that, right? No one  
35 knows anything about it.



1                   MR. PEET: Right, and as we point out in our brief, we're not  
2 required under the law to provide that theoretical basis. What is required, of  
3 course, is to provide a reproducible, predictable way, without undue  
4 experimentation, of making the claimed invention. I believe the data speaks  
5 for itself in the application that the applicant has done that.

6                   JUDGE ADAMS: All right. You have a few minutes  
7 remaining. Is there anything else you wanted to say?

8                   MR. PEET: Those were the critical points that I wanted to  
9 make and I really appreciate you taking the time.

10                  JUDGE ADAMS: Does anyone else have any questions?  
11 We don't have any outstanding questions.

12                  MR. PEET: Great. Thank you very much for taking the time to  
13 listen to my arguments.

14                  (Whereupon, at 9:20 a.m., the proceedings were concluded.)  
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